



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/051,641	01/18/2002	Nikolaus Z. Schwabe	L7059-0001	8057

7590

06/03/2003

Michael L. Diaz
Michael L. Diaz, P.C.
Suite 200
555 Republic Drive
Plano, TX 75074

EXAMINER

CONLEY, SEAN E

ART UNIT

PAPER NUMBER

1744

DATE MAILED: 06/03/2003

3

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/051,641

Applicant(s)

SCHWABE, NIKOLAUS Z.

Examiner

Sean E Conley

Art Unit

1744

-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on January 18, 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 12 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Rohowetz (U.S. Pat. 4,188,437).

With respect to the rejection of claim 12 under 35 U.S.C. 102(b), the phrase “postage stamp” is not given any patentable weight (see M.P.E.P. 706.03).

Rohowetz discloses adhesive tapes that change color in the presence of water or steam at an elevated temperature and are useful as sterilization indicators. The tapes comprise an adhesive layer and a polymeric base film containing on one surface thereof a coating of a thermotropic ink comprising a binder resin, a colorant which undergoes a color change in the presence of water or steam at elevated temperature, and a solvent blend. The adhesive is present on the back surface of the tapes and is used for affixing the indicator tapes to various surfaces. The colorant is located on the outer surface and is selected to produce a visible color change upon exposure to water or steam at elevated temperature (see column 2, lines 5-41). Also, claim 12, lines 5-6, recite the phrase “to the mail article”. This phrase is considered to be the intended use of the adhesive and is not given patentable weight.

With respect to the rejection of 12 under 35 U.S.C. 103(a), Rohowetz teaches that while the tapes are designed primarily as sterilization indicators, they may provide other functions as well. For example, the tape may be printed to incorporate a message such as advertising material (see column 7, lines 40-42). If the phrase "postage stamp" were given patentable weight, it is known to use printed matter in combination with a sterilization color indicator on an adhesive strip. Therefore, it would have been obvious to one having ordinary level of skill in the art at the time the invention was made to combine a sterilization color indicator with a postage stamp because Rohowetz teaches that it is known to combine a sterilization color indicator with printed matter on a substrate comprising an adhesive backing.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koenck et al. (Patent Application Publication US 2002/0162971 A1) in view of Melker et al. (Patent Application Publication US 2003/0072674 A1).

Koenck et al. disclose a system and method for irradiating and sterilizing mail articles that may be contaminated (see paragraphs [0058] to [0083]). The method comprises first collecting mail from "blue boxes" and individual residential mailboxes, then transporting the postal material to the post office, and finally sterilizing the mail at the post office prior to delivery of the mail to the recipients. Although the reference does not specifically disclose the step of affixing a postage stamp to the mail article it is implied that mail which has been collected by postal workers will have the proper postage stamp since postage is required in order for the mail to be delivered by the post office.

The system disclosed by Koenck et al. comprises a sterilization apparatus which has a means to sterilize a mail article using e-beam sterilization. Also, it is disclosed that other sterilizing means are available such as x-rays or gamma radiation. However, the method and system of Koenck et al. does not teach a sterilization indicator affixed to the mail articles for indicating that the sterilization process is complete.

Melker et al. discloses an adhesive strip that changes color in response to a sterilization process. In one example, the color indicator is placed on the surface of a container that is to be treated with microwaves. The indicator changes color when the indicator has reached a sufficient temperature for a sufficient period of time to achieve proper sterilization (see paragraph [0020]). The adhesive strip includes any

Art Unit: 1744

thermochromic material (capable of changing color in response to temperature) to be used as a sterilization indicator. Specific examples are disclosed in paragraph [0023]. The color indicator can be included on the surface of the substrate or may be incorporated into the adhesive layer.

Therefore, it would have been obvious to one of ordinary level of skill in the art at the time the invention was made to modify the invention of Koenck et al. and include an adhesive chemical indicator strip taught by Melker et al. affixed to the mail articles, since Melker et al. teaches that it is known to adhere a color changing chemical indicator strip to an article being sterilized in order to determine when the article has been properly sterilized.

Additionally, the phrase "postage stamp" as well as the limitations of claims 6 and 7 regarding the markings on a postage stamp which indicate a payment of postal fees are not given any patentable weight because the claim language refers to the pictures or markings on a material and these features are not held to be patentable (see M.P.E.P. 706.03). Therefore, the claims have been interpreted to include any adhesive color changing indicator strip capable of indicating when an article has been properly sterilized.

Regarding claim 8, the applicant has disclosed in the specification on page 13, line 1, that it is quite common for mail sent from larger companies or offices to utilize a postal machine which affixes an ink mark or a metering mark to the mail article. Therefore, it would have been obvious in view of the applicant's disclosure to affix a metering mark to a mail article since it is commonly known.

6. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koenck et al. (Patent Application Publication US 2002/0162971 A1) in view of Melker et al. (Patent Application Publication US 2003/0072674 A1) and further in view of Rohowetz (U.S. Pat. 4,188,437).

See previous rejection regarding the combination of references to Koenck et al. and Melker et al. If the phrase "postage stamp" were given patentable weight the claims would be obvious over Koenck et al. in view of Melker et al. and further in view of Rohowetz.

Koenck et al. and Melker et al. do not teach or disclose printed matter in combination with a sterilization color indicator and an adhesive substrate.

Rohowetz discloses adhesive tapes that change color in the presence of water or steam at an elevated temperature and are useful as sterilization indicators. The tapes comprise an adhesive layer and a polymeric base film containing on one surface thereof a coating of a thermotropic ink comprising a binder resin, a colorant which undergoes a color change in the presence of water or steam at elevated temperature, and a solvent blend. The adhesive is present on the back surface of the tapes and is used for affixing the indicator tapes to various surfaces. The colorant is located on the outer surface and is selected to produce a visible color change upon exposure to water or steam at elevated temperature (see column 2, lines 5-41).

Additionally, while the tapes are designed primarily as sterilization indicators,

Art Unit: 1744

they may provide other functions as well. For example, the tape may be printed to incorporate a message such as advertising material (see column 7, lines 40-42).

Therefore, it would have been obvious to one having ordinary level of skill in the art at the time the invention was made to further modify the invention Koenck et al. and combine the sterilization color indicator with a postage stamp because Rohowetz teaches that it is known to combine a sterilization color indicator with printed matter on a substrate comprising an adhesive backing.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: JP 02136299 A to Kinoshita

Kinoshita teaches an adhesive postage stamp that irreversibly changes color upon contact with water. Thus the stamp is prevented from being reused illegally.

Also, U.S. Pat. 4,898,762 to Brown et al. and Pub. No. US 2001/006818 A1 to Amhof et al. are considered to be relevant prior art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sean Conley, whose telephone number is (703) 305-2430. The examiner can normally be reached on Monday-Friday 7:30 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Robert Warden, can be reached at (703) 308-2920. The Unofficial fax phone number for this group is (703) 305-7719. The Official fax phone number for this Group is (703) 872-9310.

Art Unit: 1744

When filing a FAX in Technology Center 1700, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communications with the PTO that are not for entry into the file of the application. This will expedite the processing of your papers.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [robert.warden@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via internet e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified unless there is of record express waiver of the confidentiality requirements under 35 U.S.C. 122 by the applicant. See the Interim Internet Usage Policy published by the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application should be directed to the group receptionist, whose telephone number is (703) 308-0661.

SEC *AC*

May 29, 2003

Robert J. Warden, Sr.
ROBERT J. WARDEN, SR.
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700